

Rejected

unpatentable over U.S. Patent No. 5,552,994 issued to Cannon et al (Cannon Patent). The Examiner also rejected claims 46, 47, 58, 59, 70, 71 under 35 U.S.C. §103(a) as being unpatentable over the Cannon Patent in view of Official Notice regarding customer order modifications as applied to claims 45, 57, 69 and further in view of Official Notice regarding express couriers and claims 48, 49, 60, 61, 72, 73 under 35 U.S.C. §103(a) as being unpatentable over the Cannon Patent in view of Official Notice regarding customer order modifications as applied to claims 45, 57, 69 and further in view of U.S. Patent issued to Hayes. The Examiner also rejected claims 54-56, 66-68, 78-80 under 35 U.S.C. §103(a) as being unpatentable over the Cannon Patent in view of Official Notice regarding customer order modifications as applied to claims 45, 57, 69 and further in view of Chartock and further in view of the Mail List Management articles cited by the Examiner.

Double Patenting Rejection

The Examiner rejected claims 45, 57, 69 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 51, 68, and 72 of U.S. Patent No 5,960,412 and claims 1, 21, 31, 41, 45, and 49 of U.S. Patent No. 6,092,054. The Examiner noted: "Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application claim subject matter pertaining to system, method, means, and program code of electronically viewing, ordering, and delivering a social expression card to a recipient."

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Applicant has reviewed the noted claims in these two patents and believes that the claims in the present application are patentably distinct from the claims in these cited patents. In particular, the present application contains the recitation in the independent claims (such as claim 45) of: "initiate the delivery of social expression cards by said order fulfillment center to a plurality of said recipients." The recitation of the delivery of social expression cards to a plurality of recipients is nowhere articulated in the claims of these cited patents.

The cited U.S. Patent No. 5,960,412 discloses and claims a social expressions management system which stores and links recipient data and social expression card data to facilitate the on-going management, selection, and delivery of the social

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expression cards. The system also provides a user interface to permit a user to access the data to permit the user to manage, select, and facilitate the delivery of the social expression cards by selecting the mode of delivery of the social expression card. This data management capability is not the subject of the claims in the present application, which recites the delivery of social expression cards to a plurality of recipients.

Claim 1 in U.S. Patent No. 5,960,412, for example, recites:

A method for on-going management, selection, and delivery of social expression cards, the method comprising the steps of:

- (a) storing data in one or more databases, the data including recipient data and social expression card data;
- (b) linking the recipient data with the social expression card data thereby forming linked data to facilitate the on-going management, selection, and delivery of the social expression cards; and
- (c) providing a user interface to permit a user to access the data to permit the user to manage, select, and facilitate the delivery of the social expression cards.

Thus, Applicant believes that a rejection of the claims under the judicially created doctrine of double patenting using U.S. Patent No. 5,960,412 is not warranted, since claims 1, 32, 38, 45-47, 51, 68, 72, 73 contained therein do not articulate Applicant's claimed structure contained in the present application.

In addition, the cited U.S. Patent No. 6,092,054 discloses and claims a social expressions management system which provides for the on-going management, selection, and delivery of social expression cards and gifts to a recipient. The system stores and links recipient data and social expression card data to enable a user to manage, select, and facilitate the delivery of a social expression card to a selected recipient. The system also provides the user with a send-by-date to facilitate the delivery of a gift to said recipient in coordination with the social expression card. The use of a send-by date for an associated gift is not the subject of the claims of the present application, which specifically recite the delivery of social expression cards to a plurality of recipients.

Claim 1 in U.S. Patent No. 6,092,054, for example, recites:

A method for on-going management, selection, and delivery of social expression cards and gifts to a recipient, the method comprising the steps of:

storing data in at least one database, said data including recipient data and social expression card data;

linking said recipient data with said social expression card data, thereby forming linked data to facilitate the on-going management, selection, and delivery of a social expression card to a selected recipient;

providing a user interface to permit a user to access at least a portion of said data stored in said at least one database to permit the user to manage, select, and facilitate the delivery of a social expression card to said selected recipient; and

providing said user with a send-by-date to facilitate the delivery of a gift to said recipient in coordination with said social expression card.

Thus, Applicant believes that a rejection of the claims under the judicially created doctrine of double patenting using U.S. Patent No. 6,092,054 is not warranted, since claims 1, 11, 21, 31, 41, 45 and 49 contained therein do not articulate Applicant's claimed structure contained in the present application.

In summary, Applicant respectfully requests that the rejection of claims 45, 57, 69 under the judicially created doctrine of double patenting be withdrawn.

Rejection of claims 45, 50-53, 57, 62-65, 69, 74-77 under 35 U.S.C. §103(a)

In rejecting Applicant's claims 45, 50-53, 57, 62-65, 69, 74-77 under 35 U.S.C. §103(a), the Examiner relied on the Cannon Patent, noting (in pertinent part) with respect thereto:

Cannon et al teach printing cards at the user location or at remote locations, transacting multiple card orders Cannon et al teach a known problem of card purchasers not remembering what card designs they have previously sent to a recipient and concerns about sending duplicates of cards previously sent, an order information database, multiple modes of delivery (e.g., mail or delivered as noted in prior art), order information storage and retrieval, and unique order identifiers to retrieve orders (see at least abstract; Fig. 1 (15, 19); Fig. 3 (40, 50); 3a (36); Fig. 18 (52, 54, 66, 67, 68); col. 1, line 15 through col. 5, line 39).

The Examiner also noted that Cannon et al. further teach the following:

Providing a customer interface to access databases and image files stored in a central data storage unit which may be accessed at a card display/order site facility and a card printing facility (see at least Fig. 18 (65, 66); col. 4, lines 56-59),

Assigning each customer order with a unique order code and the order code being stored in the order information database and retrieved by

the card printing facility for processing (see at least Fig. 19 (74): col. 4, lines 6-8; col. 18, line 59),

Receiving an order initiated by a customer transmitting the order to a card printing site (see at least col. 17, lines 22-25),

Printing and shipping cards ordered by a customer, with order information stored in an order information database (see at least Fig. 20b (79)),

Updating the order information to reflect the date the orders [sic] was processed and shipped (see at least Fig. 19 (85, 86); col. 19, lines 63-65), and

Noting a known problem of card purchasers not remembering what card designs they have previously sent someone and being concerned about sending duplicates of cards previously sent (see col. 3, lines 50-55).

The Examiner further notes that Cannon "do not disclose the customer accessing the databases to make a change to an order." The Examiner then "takes the position that Cannon et al. substantially describe a system and method that allow the customer to initiate the delivery of social expression cards by an order fulfillment center, either as a first time order or a modified order." The Examiner then:

"takes the position should a customer decide to change the delivery date or any other type of supplied information (e.g. typing error, occasion date change beyond customer control necessitating a delivery date change, changing personalized message), it would be a reasonable expectation on the part of the customer to be able to initiate changes due to human error or events beyond the control of the customer, if not via the customer terminal then simply by sending in hand written order form via facsimile transmission to make the necessary changes (see at least col. 17, lines 3-13). Furthermore, since the order status is updated in the customer order information, the customer would be able to determine order status through the order site, or at least via facsimile transmission requesting an order status update. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system and method of Cannon et al. to allow customer access to order data once entered to review or modify the order as taught by Official Notice, in order to provide customer service flexibility and better convenience to the customer, and thereby attract more customers to the site."

Applicant has reviewed the Examiner's comments and believes that the Cannon Patent fails to show or suggest the structure recited in Applicant's claims 45, 50-53, 57, 62-65,

69, 74-77, for the reasons articulated below. Applicant believes that claims 45, 50-53, 57, 62-65, 69, 74-77 are allowable over the cited Cannon Patent under 35 U.S.C. §103(a), given the proper application of 35 U.S.C. §103(a) to Applicant's claims.

Characterization of the Cannon Patent

The Cannon Patent discloses a kiosk-based card ordering system where the user can only order a single card for a single recipient in a single transaction from a terminal, either a kiosk, personal computer, or cable television set-top box. The preferred embodiment of the system for printing social expression cards disclosed in the Cannon Patent consists of a personal computer-based card kiosk which enables a user to select and order a single greeting card from a remotely located card printing facility, using the personal computer-based card kiosk to access a database of card designs. The database of card designs can be located in the kiosk or at the printing facility. One significant limitation of the Cannon system for printing social expression cards is that it is a single transaction card purchase system that does not provide the user with the capability to store data relating to: multiple recipients, recipient addresses, recipient occasions, order history, order status. This single card focus is succinctly described in the Cannon Patent: "The user can order a selected card to be printed and input information to personalize the card. The order is then electronically transmitted to a card printing facility for printing." (column 4, lines 64-67) The user's transaction for the printing of a single card for a single recipient is processed by the printing facility of the Cannon system and the data, input by the user relating to the recipient and the occasion, are thenceforth unavailable to the user, since the Cannon Patent fails to even hint at maintaining a database of consumer information that enables a consumer to populate a database with a plurality of recipient data records. In addition, the Cannon Patent is totally devoid of even a hint of printing multiple cards pursuant to the single card order entry transaction. Thus, the focus of the Cannon system for printing social expression cards is exclusively to print a single social expression card for a single recipient via a transaction-based public kiosk, with all of the data input by the user being transient in nature: input by the user, transmitted to the card printing facility and forever beyond the reach of the user and discarded once it is used to print the card.

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The Examiner mistakenly noted: "Cannon et al teach transacting multiple card orders", but a careful reading of the entirety of the Cannon Patent fails to reveal even a hint of the ability to initiate more than a single card order in a transaction or the ability to order multiple cards in any mode in the single transaction. The Examiner then notes that "Cannon et al teach a known problem of card purchasers not remembering what card designs they have previously sent to a recipient and concerns about sending duplicates of cards previously sent". However, it is interesting to note that the Cannon Patent is totally devoid of any suggestion of how to address this problem. The above-noted rhetorical comment in the Cannon Patent is not a disclosure of any teaching of how to solve the problem articulated and therefore does not constitute prior art for the purposes of an obviousness rejection of Applicant's claims.

Applicant's Claimed System

In contrast, Applicant's social expressions management system enables a consumer to populate a database with a plurality of recipient data records, then link the recipient data with social expression card data to facilitate the on-going management, selection, and delivery of social expression cards. The consumer has the ability "to access the data to permit said customer to initiate the delivery of social expression cards by said order fulfillment center to a plurality of said recipients." Thus, the consumer can execute a transaction that addresses the social expression needs for a plurality of recipients and a plurality of occasions, with Applicant's system maintaining a database to reflect the complex nature of the consumer's social expression needs and to facilitate the on-going management, selection, and delivery of social expression cards. This ability to store a plurality of recipient data records, then link the recipient data with social expression card data to facilitate the on-going management, selection, and delivery of social expression cards to facilitate the on-going management, selection, and delivery of social expression cards and enable the consumer to order social expression cards for a plurality of recipients is not even hinted at by the Cannon Patent, yet is specifically recited in Applicant's independent claim 45, for example:

A method for initiating fulfillment of a consumer order in a system where a consumer communicates with an order fulfillment center, the method comprising the steps of:

storing data in at least one database, the data including a plurality of recipient data records for said customer, each of said customer's recipient data records containing data which defines a recipient;

linking the recipient data with social expression card data, containing data which defines at least one social expression card, thereby forming linked data to facilitate the on-going management, selection, and delivery of social expression cards; and

providing a customer interface to permit said customer to access the data to permit said customer to initiate the delivery of social expression cards by said order fulfillment center to a plurality of said recipients.

In fact, in support of Applicant's position, the Examiner asserts that Cannon "do not disclose the customer accessing the databases to make a change to an order." The Examiner then "takes the position that Cannon et al. substantially describe a system and method that allow the customer to initiate the delivery of social expression cards by an order fulfillment center, either as a first time order or a modified order" and provides a lengthy reverse engineering description of how the system of the Cannon Patent can be modified to mimic Applicant's system. However, there is no support for the Examiner's position since the Cannon Patent is completely devoid of even a hint of "providing a customer interface to permit said customer to access the data" as is specifically recited in Applicant's independent claim 45. The printing facility 40 of the Cannon Patent is described in excruciating detail (column 14, line 45 - column 15, line 33), including the minutiae of implementation details of the keyboard, mouse, processor, hard drives, modems, software, printer, etc., including a recitation of the most minor product implementation details of each and every element. However, it is important to note that **NO REFERENCE is made to a USER INTERFACE** anywhere in the specification, drawings or claims (In particular, see Figure 3a, Figure 19, Figure 21 and accompanying descriptions) of the Cannon Patent that would enable the user to access, edit and approve order information that had been previously entered into the system as is suggested by the Examiner. In fact, the Cannon Patent teaches away from this concept, since the printing facility is equipped only with a FAX MODEM (SupraFAXModem V.32bis) to enable order receipt from the various display/order systems 50. The Cannon Patent describes numerous ways for the consumer to fill out and order form via kiosks, cable television systems, personal computer systems, fax forms, and the like, however,

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once the order form is transmitted to the Cannon printing facility, it is beyond the reach of the consumer, since the Cannon system has no user interface, only a modem for receiving completed card orders.

Obviousness Test

Since the Examiner's rejection of Applicant's claims is based on 35 U.S.C. §103(a), it is relevant to review the application of this rejection.

The MPEP and courts have stated that the Examiner must show the following:

"1.) A motivation or suggestion to combine references, 2.) A reasonable expectation of success from combining the references, and 3.) The combined references teach all of the limitations of the claimed invention." MPEP § 706.02(j); See also *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991).

In order to meet the first of the above-noted three requirements by the MPEP for prima facie obviousness, the following must be shown: 1.) one or more references, 2.) The references were available to the inventor at the time of the claimed invention, 3.) each of the references teaches an element of the claimed invention, 4.) the prior art contains a suggestion or a motivation to combine the references, 5.) the combination of the references would have made the invention obvious. See *In re Rinehart*, 189 USPQ 143, 147 (C. C. P. A. 1976); *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Fitch*, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

As noted above, the Cannon Patent fails to teach all of the recited elements of Applicant's claims. The Examiner admits that Cannon "do not disclose the customer accessing the databases to make a change to an order." The Examiner has therefore attempted to supply the elements not shown or suggested by the Cannon Patent based on the Examiner's perception of what would be desirable to a consumer to improve the limited teaching of the Cannon Patent.

No Suggestion to Combine – Hindsight Needs to Be Avoided

A brief examination of "hindsight" law as handed down by the Federal Circuit superimposed upon the facts of this case will be helpful. The hindsight approach was criticized in *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303, 312-313 (Fed. Cir. 1983):

"To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher."

The Federal Circuit repeated its prohibition against "hindsight." In *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 5 USPQ 2d 1434, 1438, 1439 (CAFC 1988), the Federal Circuit held:

"When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself." Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.

* * * * *

There is no suggestion in any individual prior art reference of such a combination of location and configuration nor is it suggested by the prior art as a whole. ([I]t is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention). (Emphasis added; citations omitted)

The proper approach to an obviousness analysis was explained as follows:

"In order to prevent a hindsight-based obviousness analysis, we have clearly established that the relevant inquiry for determining the scope and content of the prior art is whether there is a reason, suggestion, or motivation in the prior art or elsewhere that would have led one of ordinary skill in the art to combine the references. See, e.g., *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed.Cir.1998) ("[T]he Board must identify specifically The reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617 ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."). *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664-5, 57 U.S.P.Q.2d 1161 (Fed. Cir.2000).

Specific demonstration of a motivation to combine is required.

"The district court opinion does not discuss any specific evidence of motivation to combine, but only makes conclusory statements. "Broad conclusory statements regarding the teaching of multiple references,

standing alone, are not 'evidence.'" *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617." *Ecolochem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 1372, 56 U.S.P.Q.2d 1065 (Fed.Cir.2000).

In applying the hindsight test, the Examiner has failed to show: "4.) the prior art contains a suggestion or a motivation to combine the references," since in fact, the Cannon Patent teaches away from the combination suggested by the Examiner. The absence of even a hint of a user interface contradicts the Examiner's suggestion that with respect to the Cannon Patent "it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system and method of Cannon et al. to allow customer access to order data once entered to review or modify the order."

Furthermore, the Examiner has shown no combination of references that address Applicant's claimed structure wherein a consumer can execute a transaction that addresses the social expression needs for a plurality of recipients and a plurality of occasions, with Applicant's system maintaining a database to reflect the complex nature of the consumer's social expression needs and to facilitate the on-going management, selection, and delivery of social expression cards. This ability to store a plurality of recipient data records, then link the recipient data with social expression card data to facilitate the on-going management, selection, and delivery of social expression cards to facilitate the on-going management, selection, and delivery of social expression cards and enable the consumer to order social expression cards for a plurality of recipients is not even hinted at by the Cannon Patent, yet is specifically recited in Applicant's independent claim 45, for example.

Thus, Applicant believes that claims 45, 50-53, 57, 62-65, 69, 74-77 are allowable under 35 U.S.C. §103(a) over U.S. Patent No 5,552,994 issued to Cannon in combination with the Examiner's suggestions, since the Cannon Patent fails to show or suggest the limitations recited in these claims and in fact teaches away from the modifications suggested by the Examiner.

Rejection of claims 46-49, 54-56, 58-61, 66-68, 70-73, 78-80 under 35 U.S.C. §103(a)

The Examiner also rejected claims 46, 47, 58, 59, 70, 71 under 35 U.S.C. §103(a) as being unpatentable over the Cannon Patent in view of Official Notice regarding

customer order modifications as applied to claims 45, 57, 69 and further in view of Official Notice regarding express couriers and claims 48, 49, 60, 61, 72, 73 under 35 U.S.C. §103(a) as being unpatentable over the Cannon Patent in view of Official Notice regarding customer order modifications as applied to claims 45, 57, 69 and further in view of U.S. Patent issued to Hayes. The Examiner also rejected claims 54-56, 66-68, 78-80 under 35 U.S.C. §103(a) as being unpatentable over the Cannon Patent in view of Official Notice regarding customer order modifications as applied to claims 45, 57, 69 and further in view of Chartock and further in view of the Mail List Management articles cited by the Examiner. Applicant believes that claims 46-49, 54-56, 58-61, 66-68, 70-73, 78-80 are allowable under 35 U.S.C. §103(a) since they depend on allowable base claims as well as being allowable over the cited Cannon Patent individually as well as in view of the cited Hayes reference, since these references fail to even hint at Applicant's claimed ability to store a plurality of recipient data records, then link the recipient data with social expression card data to facilitate the on-going management, selection, and delivery of social expression cards and to also enable the consumer to order social expression cards for a plurality of recipients.


Summary

The Applicant requests a Notice of Allowance in this application in light of the amendments and arguments set forth herein. The undersigned attorney requests Examiner Pond to telephone if a conversation could expedite prosecution. Applicant authorizes the Commissioner to charge any additionally required payment of fees to deposit account #50-1848.

Customer Number 024283

Respectfully submitted,
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